

REMARKS

Claims 1-20 are pending in the present application.

Claims 1-20 have been rejected.

No claims have been allowed.

Claims 1, 10, 11, 17 and 18 have been amended solely to correct antecedent basis problems noted by the Applicants.

Claims 1-20 remain in the present application.

Reconsideration of the claims is respectfully requested in view of the following arguments.

In Section 2 of the July 14, 2004, Office Action, the Examiner rejected Claims 1, 2, 5-7, 11 and 12 under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,223,028 to *Chang et al.* (“*Chang*”) in view of United States Patent No. 6,622,017 to *Hoffman* (“*Hoffman*”). In Section 3 of the Office Action, the Examiner rejected Claims 10, 16, 17 and 20 under 35 U.S.C. 103(a) as being unpatentable over *Chang* and *Hoffman* and further in view of United States Patent No. 5,819,177 to *Vucetic et al.* (“*Vucetic*”). In Section 4 of the Office Action, the Examiner rejected Claims 3, 4, 8, 9, 13-15, 18 and 19 under 35 U.S.C. 103(a) as being unpatentable over *Chang*, *Hoffman* and *Vucetic* and further in view of United States Patent No. 6,314,282 to *Weber et al.* (“*Weber*”).

Initially, the Applicants note that the filing date of the *Hoffman* reference is later than the filing date of the present application. While the *Hoffman* reference claims priority to a provisional application filed before the present application, the Office Action does not demonstrate that the

passages relied upon in the Examiner's rejections are found in the provisional application. Absent such a demonstration, the applicants respectfully assert that the Examiner has failed to meet his initial burden of factually supporting a *prima facie* conclusion of obviousness, as required in MPEP § 2142. The Applicants respectfully request that the Examiner demonstrate that the cited passages are found in the provisional application. Assuming, without admitting, that support for the cited passages can be so found, the Applicants respectfully traverse the rejections under 35 U.S.C. 103(a).

The Applicants direct the Examiner's attention to Claim 1, which contains the unique and novel limitations emphasized below:

1. (Currently Amended) For use in a wireless network comprising a plurality of base stations, each of said base stations capable of communicating with a plurality of mobile stations, a service provisioning system capable of provisioning a first one of said plurality of mobile stations comprising:

a database capable of storing a service provisioning file comprising a mobile station service provisioning program in interpreted byte-code format; and

a provisioning controller coupled to said database capable of receiving a notification indicating that said first mobile station is unprovisioned and further capable, in response to receipt of said notification, of retrieving said service provisioning file from said database and transmitting said service provisioning file to said first mobile station, wherein receipt of said service provisioning file causes said first mobile station to automatically execute said mobile station service provisioning program in said service provisioning file, execution of said mobile station service provisioning program automatically provisioning said first mobile station without further interaction from a service operator.

(emphasis added)

The Applicants respectfully assert that the above-emphasized limitations are not disclosed in the *Chang* reference, the *Hoffman* reference, or in the combination of the *Chang* reference and the *Hoffman* reference.

The Examiner asserts that *Chang* describes a database capable of storing a service provisioning file comprising a mobile station service provisioning program in interpreted byte-code format at column 4, lines 34-39, and Table 1. The cited passage states:

With reference now to Table I, there is depicted a list of parameters in a protocol capability response message from a mobile to a base transceiver station over the air within mobile telephone communication network 10, in accordance with a preferred embodiment of the present invention.

Table I is a list of message fields and their lengths. As such, the cited passage and table describe a message sent from a mobile station to a base transceiver station, rather than a database as recited in Claim 1.

Additionally, the Office Action argues that *Hoffman* shows a system which retrieves a service provisioning file from a database, transmits the file to a mobile station, wherein receipt of the file causes the mobile station to automatically execute a mobile station service provisioning program in interpreted byte-code format in the file, the execution of the program by the mobile station automatically provisioning the mobile station without further interaction from a service operator. The Examiner cites the final three clauses of Claim 1 of the *Hoffman* reference, at column 16, lines 38-48, in support of this argument. That claim recites a method which includes the steps of:

- retrieving one of the executable program modules from the database, the retrieved module corresponding to the selected feature;
- downloading the retrieved module into the substantial portion of the program memory in the one programmable wireless communication terminal, to enable the one wireless communication terminal to implement the selected feature; and
- automatically provisioning at least one element of the wireless communication network to activate a subscription service corresponding to the selected feature.

The downloaded programs are described as plug-in software modules, written to the application program interface (API) specifications of the core software of the mobile station. *See Hoffman, col. 2, lines 32-34.* The mobile station includes a microprocessor and flash memory for storing the microprocessor's core programming and plug-in feature modules. *See Hoffman, col. 12, lines 48-57.* The feature modules are written to the specifications of the hardware and the API of the particular type of handset. *See Hoffman, col. 15, lines 49-51.* As such, the *Hoffman* reference does not teach a service provisioning system in which a mobile station automatically executes a mobile station service provisioning program in interpreted byte-code format, as recited in independent Claim 1.

Furthermore, when the *Hoffman* reference describes the provisioning of a mobile station, it does not teach that execution of the downloaded program by the mobile station automatically provisions the mobile station without further interaction from a service operator. On the contrary, *Hoffman* describes the carrier's customer service center as performing the provisioning of a mobile station. *See Hoffman, col. 9, lines 25-27, and col. 10, lines 5-20.*

For these reasons, the Applicants respectfully assert that neither the *Chang* reference, the *Hoffman* reference, nor the combination of the *Chang* and *Hoffman* references teaches a service provisioning system comprising a database capable of storing a service provisioning file comprising a mobile station service provisioning program in interpreted byte-code format, and a mobile station which, upon receipt of the service provisioning file, automatically executes the mobile station service provisioning program to automatically provision the mobile station without further interaction from a

service operator, as recited in independent Claim 1. Furthermore, the Applicants respectfully assert that the *Vucetic* and *Weber* references do nothing to overcome this shortcoming.

This being the case, Claim 1 presents patentable subject matter over the *Chang* reference and the *Hoffman* reference. Additionally, dependent Claims 2-5, which depend from Claim 1, contain all of the unique and novel limitations recited in independent Claim 1. Claims 2-5 are therefore patentable over the *Chang* reference and the *Hoffman* and *Weber* references.

Furthermore, independent Claims 6, 11 and 16 recite limitations that are analogous to the unique and novel limitations recited in Claim 1. This being the case, Claims 6, 11 and 16 are patentable over the *Chang* reference and the *Hoffman* and *Vucetic* references. Dependent Claims 7-10, 12-15 and 17-20, which depend from Claims 6, 11 and 16, respectively, contain all of the unique and novel limitations recited in independent Claims 6, 11 and 16. Thus, Claims 7-10, 12-15 and 17-20 are patentable over the *Chang* reference and the *Hoffman*, *Vucetic* and *Weber* references.

SUMMARY

For the reasons given above, the Applicants respectfully request reconsideration and allowance of pending claims and that this Application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@davismunck.com*.

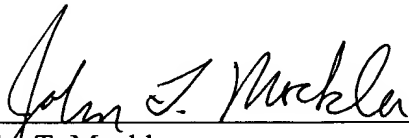
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 4 Oct. 2004

P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: *jmockler@davismunck.com*



John T. Mockler
Registration No. 39,775